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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,969	01/05/2001	Evan S. Huang	2276-02	3976

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EXAMINER
BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/754,969	Applicant(s) HUANG, EVAN S.	
	Examiner William L. Bashore	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 July 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-27 and 29-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-27 and 29-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is responsive to communications: amendment filed 7/20/2002, to the original application filed 1/5/2001, with provisional filing date of **1/31/2000**. IDS filed 4/23/2001 and 4/25/2001.

2. The rejection of claims 1-7, 9-31, 33-42 under 35 U.S.C. 103(a) as being unpatentable over Borgendale, Fuji Xerox, and Fallside has been withdrawn as necessitated by amendment.

3. Allowable subject matter indicated in the previous office action regarding claims 8, and 32 has been withdrawn as necessitated by amendment.

4. Claims 1-3, 5-27, 29-42 are pending. Claims 4, 28 have been canceled. Claims 1, 15, 25, 39 are independent claims.

Examiner's Note

5. It is noted that Applicant's amendment regarding associating independent claim limitations with generation and display of a tree structure showing hierarchical relationships of document elements (along with cancellation of claims 4, 28), significantly changes the scope of the claimed invention when said claims (including dependent claims) are read as a whole.

Claim Rejections - 35 USC § 103

6. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. **Claims 1-3, 5-27, 29-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgendale et al. (hereinafter Borgendale), U.S. Patent No. 5,276,793 issued January 1994, in view of Fallside, U.S. Patent No. 6,003,048 issued December 1999, and further in view of Arn et al. (hereinafter Arn), PCT International Application Publication No. WO 94/14122, Application No. PCT/CA93/00525, Publication date: 23 June 1994.**

In regard to independent claim 1, Borgendale teaches an editor for producing/modifying structured documents (Borgendale Abstract; compare with claim 1 "*a method of producing structured documents, the method comprising:*").

Borgendale teaches receiving a document within a document construction module with DTDs, which can reside on a diskette (Borgendale column 8 lines 39-46; compare with claim 1 "*receiving a definition file including document type definitions (DTD)*").

Borgendale teaches a file including a number of objects indicative of "decorative" attributes, such as font, etc. (Borgendale Figures 19-21 - middle section in each figure; compare with claim 1 "*....respective decoration attributes about each of the displayable objects*"). Borgendale also teaches a tree structure comprising hierarchical relationships of various document tags (elements) (Borgendale Figure 11). However, Borgendale does not specifically teach displaying said tree to a user along with a document. However, Arn teaches display of structural documents in a left hand pane comprising hierarchically nested elements (a tree of elements), said elements associated with portions of a document displayed in a right hand pane (Arn Abstract, Figures 1-6). It is to be noted that the display of elements are also associated with the document's DTD, acting to constrain the user to only those modifications allowed by said document's DTD (Arn page 3 lines 1-14, page 6 lines 23-30, page 7 lines 2-4, page 8 lines 1-20; compare with claim 1 "*... to generate a tree structure showing hierarchical relationships of document elements*", and "*associating at least one of the document elements....with one of the displayable objects*"). It would have been obvious to one of ordinary skill in the art at the time of the

invention to apply the display of Arn to Borgendale's tree structure, providing a user of Borgendale the benefit of easier manipulation of elements, and helping to constrain a user to a particular DTD (Arn page 6 lines 23-29).

Borgendale teaches creation of a structured document subsequent to a user's document editing and interaction with a document construction module (Borgendale column 14 lines 20-31, 58-65; compare with claim 1 "*creating the structured document....*"). Borgendale does not specifically teach creating said structured document from an initial output presentation. However, Fallside teaches conversion of a coordinate based document (image based) to an equivalent tag based structured document (a markup language document) (Fallside Abstract, Figure 5A, column 3 lines 50-67 to column 4 lines 1-23; compare with claim 1 "*creating the structured document from the output presentation*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fallside to Borgendale, providing Borgendale the capability of creating structured documents from initial inputted image files, increasing Borgendale's versatility by converting an array of different input document types.

In regard to dependent claim 2, Borgendale teaches style information in the form of an "MLOOK" set, which is indicative of a metafile associated with modified elements, as well as associated with a DTD (Borgendale column 6 lines 66-68, column 7 lines 60-65; compare with claim 2).

In regard to dependent claim 3, Borgendale teaches converting a document with metafile to SGML utilizing a defined element look table, and a Structure table (Borgendale column 6 lines 22-32, Figures 5, 11, 12; compare with claim 3).

In regard to dependent claim 4, Borgendale teaches a document type definition, which describes a structure for document elements corresponding to displayable objects in a metafile (Borgendale column 6 lines 34-37; compare with claim 4).

In regard to dependent claim 5, Borgendale teaches document elements in a hierarchical presentation, each corresponding to objects in a metafile (Borgendale Figure 11; compare with claim 5).

In regard to dependent claim 6, Borgendale teaches document identifiers associated with elements and pointers (Borgendale Figures 11, 12; compare with claim 6).

In regard to dependent claim 7, Borgendale teaches identifiers as alphanumeric text, as well as font, color, style (Borgendale column 6 lines 23; Figure 12 item Element Tag; compare with claims 7-8).

In regard to dependent claim 8, Borgendale does not specifically teach selection from a group of elements (font, color, size, style, effect). However, Arn teaches selection from a group of element identifiers, including a style (Arn Figure 1). It would have been obvious to one of ordinary skill in the art at the time of the nvention to apply Arn to Borgendale, providing a user of Borgendale the convenience of selecting from a group of elements associated with a document's DTD.

In regard to dependent claims 9-11, Borgendale teaches a construction module used for the creation/modification of documents associated with DTDs utilizing defined/modified looks, user modification of said document with respect to alphanumeric text, color, font, size, and style results in changes in identifiers (Borgendale column 6 lines 23, column 13 lines 18-40; compare with claims 9-11).

In regard to dependent claims 12-14, Borgendale teaches an editor whereby a user can generate documents associated with a DTD, said document can be initially generated as a text document, and resulting "look" of said document reflects characters, font, size, etc. (Borgendale Abstract, near top, also Figures 11-12; compare with claims 12-14).

In regard to independent claim 15, Borgendale teaches an editor for producing/modifying structured documents (Borgendale Abstract; compare with claim 15 "*a method of producing a structured document, the method comprising:*").

Borgendale teaches receiving a document within a document construction module with DTDs, which can reside on a diskette (Borgendale column 8 lines 39-46; compare with claim 15 "*a definition file including document type definitions*").

Borgendale teaches a file including a number of objects indicative of "decorative" attributes, such as font, etc. (Borgendale Figures 19-21 - middle section in each figure; compare with claim 15 "*....respective decoration attributes about each of the displayable objects*"). Borgendale also teaches a tree structure comprising hierarchical relationships of various document tags (elements) (Borgendale Figure 11). However, Borgendale does not specifically teach displaying said tree to a user along with a document, as well as first and second displays. However, Arn teaches display of structural documents in a left hand pane comprising hierarchically nested elements (a tree of elements), said elements associated with portions of a document displayed in a right hand pane (Arn Abstract, Figures 1-6). It is to be noted that the display of elements are also associated with the document's DTD, acting to constrain the user to only those modifications allowed by said document's DTD (Arn page 3 lines 1-14, page 6 lines 23-30, page 7 lines 2-4, page 8 lines 1-20; compare with claim 15 "*activating an environment....including a number of displayable objects*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the display of Arn to Borgendale's tree structure, providing a user of Borgendale the benefit of easier manipulation of elements, and helping to constrain a user to a particular DTD (Arn page 6 lines 23-29).

Borgendale teaches a document construction module comprising groups of DTDs and corresponding sets of base-styles, as well as a document type definition with a file indicating a base style for a document (a metafile) said files revealing an association of elements and objects (Borgendale

column 8 lines 40-46, column 13 lines 18-30, Figures 19-21). Borgendale does not specifically display these groupings to a user. However, Arn teaches associated groupings of displayed element objects nested within other objects (Arn Figure 1; compare with claim 15 "*forming a number of group objects....in one of the document elements*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Arn to Borgendale, providing a user of Borgendale the benefit of visualizing element/object groupings as applied to a displayed document.

Borgendale teaches creation of a structured document subsequent to a user's document editing and interaction with a document construction module (Borgendale column 14 lines 20-31, 58-65; compare with claim 15 "*creating the structured document ....*"). Borgendale does not specifically teach creating a structured document from an initial output presentation. However, Fallside teaches conversion of a coordinate based document (image based) to an equivalent tag based structured document (a markup language document) (Fallside Abstract, Figure 5A, column 3 lines 50-67 to column 4 lines 1-23; compare with claim 15 "*output presentation*", and "*creating the structured document from the output presentation*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Fallside to Borgendale, providing Borgendale the capability of creating structured documents from initial inputted image files, increasing Borgendale's versatility by converting an array of different document types.

In regard to dependent claim 16, Borgendale teaches style information in the form of an "MLOOK" set, which is indicative of a metafile associated with modified elements, as well as associated with a DTD (Borgendale column 6 lines 66-68, column 7 lines 60-65; compare with claim 16).

In regard to dependent claim 17, Borgendale teaches converting a document with metafile to SGML utilizing a defined element look table, and a Structure table (Borgendale column 6 lines 22-32, Figures 5, 11, 12; compare with claim 17).

In regard to dependent claim 18, Borgendale teaches a markup language (SGML) which is generally suitable for display on applications made to interpret said language (Borgendale column 6 lines 25-33; compare with claim 18).

In regard to dependent claims 19-20, Borgendale teaches SGML (Borgendale column 6 lines 25-33). Borgendale does not specifically teach the Internet. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, because SGML and hypertext suggests an Internet embodiment, providing the advantage of a familiar communication medium to Borgendale.

In regard to dependent claims 21-22, Borgendale teaches an editor whereby a user can generate documents associated with a DTD, said document can be generated as a text document, and resulting "look" of said document reflects characters, font, size, etc., as well as resulting character objects (Borgendale Abstract, near top, also Figures 11-12; compare with claims 21-22).

In regard to dependent claim 23, Borgendale teaches identifiers as alphanumeric text, as well as font, color, style (Borgendale column 6 lines 23; Figure 12 item Element Tag; compare with claim 23).

In regard to dependent claim 24, Borgendale teaches a construction module used for the creation/modification of documents associated with DTDs utilizing defined/modified looks, user modification of said document with respect to alphanumeric text, color, font, size, and style results in changes in identifiers (Borgendale column 6 lines 23, column 13 lines 18-40; compare with claim 24).

In regard to independent claim 25, claim 25 reflects the computer program product (medium) comprising computer readable code used for performing the methods as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claims 26-27, 29-38, claims 26-27, 29-38 reflect the machine readable medium comprising computer readable instructions for performing the methods as claimed in claims 2-3, 5-14 respectively, and are rejected along the same rationale.

In regard to independent claim 39, claim 39 reflects the computer program product (medium) comprising computer readable code used for performing the methods as claimed in claim 15, and is rejected along the same rationale.

In regard to dependent claims 40, 41, 42, claims 40, 41, 42 reflect the machine readable medium comprising computer readable instructions for performing the methods as claimed in claims 16, 17, 21 respectively, and are rejected along the same rationale.

8. **Prior art made of record and not relied upon is considered pertinent to disclosure.**

Maslov	U.S. Patent No. 6,466,240	issued	10/2002
Sato et al.	U.S. Patent No. 6,014,680	issued	01/2000

Response to Arguments

9. Applicant's arguments filed 7/20/2002 have been fully and carefully considered but they are not persuasive.

It is noted that Applicant's arguments on pages 6-8 of the amendment are substantially directed to amended subject matter. Accordingly, the examiner has incorporated newly found reference (Arn) to teach relevant limitations. See also Examiner's Note (paragraph 5).

Applicant argues on page 8 of the amendment that Fallside does not depend upon a DTD to generate a tag file. The examiner notes that Fallside is relied upon to teach conversion of a non-hypertext document to a hypertext (structured) document.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is **(703) 308-5807**. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on **(703) 308-5186**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 305-3900**.

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7239 (for formal communications intended for entry)

or:

(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

or:

(703) 746-7238 (for after-final communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).

JOSEPH H. FEILD
PRIMARY EXAMINER

William L. Bashore
10/18/2002